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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/228,109
Filing Date: January 11, 1999
Appellant(s): BRADY ET AL.

Roger S. Dybvig
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 21 May 2008 appealing from the Office action mailed 24 October 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal No. 2001-1477.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct. (It is noted that in the first paragraph of section V, it states that there are 5 independent claims instead of 3. This appears to be a typo, in the fact, that there are 5 independent claims in the application but only 3 are on appeal.)

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

PRESTO instruction manual "UNDER CABINET AUTOMATIC CAN OPENER PLUS" National Presto Industries, Inc. 1989

4,152,831	DAVIES	5-1979
5,791,608	NIELSEN et al.	8-1998
5,494,176	ZALLO	2-1996
2,720,189	NEWMAN	10-1955
6,253,662	ZELSON	7-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

- The drawings stand objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, “the housing comprising a holder and a sheath”, of claims 11 and 13, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
- Claims 11 and 13 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In both claims 11 and 13, the phrase “a sheath” is unclear. Independent claim 10 discloses the appliance comprises a scissors holder while claims 11 and 13 further limit claim 10 by disclosing the appliance further comprises a sheath. As written the appliance

comprises an independent scissors holder on the housing and an independent sheath on the housing with no linking phrase between the sheath and the holder. It is clear from the specification and claims 3 and 5 that the sheath further includes a holder structure. Making it clear that the housing does not comprise both a separate sheath and a separate holder. It is quite clear that the housing does comprise a sheath, wherein the sheath further comprises a holder structure. Using applicant's Figure 3, the holder is made up of items 60 and 62. In order for item 60 and 62 to be considered a clamp/holder both 60 and 62 must be present. It is clear that item 62 is secured to the cover of the sheath 54. So without the cover making the sheath, the holder/clamp structure cannot be mounted on the housing. Also Figure 3 clearly shows that item 62 is secured to the sheath with item 64. Making the holder/clamp part of the sheath structure. Claims 11 and 13 need to be amended along the lines of "wherein the scissors holder is a sheath" or "wherein the scissors holder is located within a sheath". The specification and Figures clearly only provide support for a single scissors holder/sheath, which is formed by a rear wall and a cover member. As written, claims 11 and 13 can be interpreted that the can opener includes a sheath structure and an independent holder structure.

- Claims 3, 7, and 10-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the PRESTO CAN OPENER PLUS (previously cited and, hereafter, to be called Presto) in view of Davies (4,152,831) and Nielsen et al.

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(5,791,608) with evidence patents Zallo (5,494,176) and Newman (2,720,189).

Presto teaches an electric can opener having substantially everything claimed – including a jar opener mounted on the bottom wall of the can opener. See page 8 of the instructions in Presto for the jar opener. Presto does not teach a scissors releasably retained to the can opener such as by a sheath. However, Davies teaches that a scissors-like tool, which one of ordinary skill in the art can call scissors, may be attached to any surface where it is convenient via a sheath in which the sheath allows access to the scissors. See col. 2, lines 26-30, and see col. 3, lines 30-31 in Davies. Nielsen et al. teaches that a scissors may be secured via a sheath to a home appliance such as a machine in the form of a sewing machine, a refrigerator, or a washer or a dryer. See col. 2, lines 26-34 in Nielsen et al. This provides evidence that it is old and well known for structures, that are in an area that scissors are to be used, to incorporate a scissors sheath. The Presto can opener presents convenient surfaces such as its sides, top, and back and is clearly a home appliance that can be defined as a machine.

Therefore, to provide a scissors removably retained to the can opener in Presto via a sheath is suggestive from Davies since the can opener presents available, convenient surfaces. This is further made obvious by Nielsen et al. for teaching that it would have been obvious to provide a sheathed scissors on any convenient surface where it might be desired for use and wherein that surface is a machine in the form of a home appliance. Thus, clearly, the collective teachings of Davies and Nielsen et al. teach that it would have been obvious to

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provide a scissors, and a sheath for the scissors, on any available surface of an appliance where such scissors and sheath might be deemed useful or is considered a desirable location for the use of the scissors and sheath. Also, dependant upon the orientation of the can opener, the “back” could be considered any of the walls. For example, if one was using the apparatus, disclosed by Presto, from the side, the left wall would be the front, the right wall would be the back, and the can opener portion would be the side. Since the Presto can opener is an appliance with available space, it would have been obvious to place a scissors and sheath on the can opener if one so desired. To place the sheath on the back of the housing of the can opener, as set forth is claims 3 and 7, would have been an obvious matter of choice of said available, convenient spaced as desired. Moreover, “back” can include several surfaces of the can opener. Further regarding claims 3 and 7, it is noted that the applied sheath of Davies includes various holders such as at 20, 21, 22, 23, or 36, or, 37, 38. Any of these holders would have been obvious in the combination to make the scissors readily removable, but secure, in it sheath. The claim would have been obvious because a person of ordinary skill has good reason to pursue the known options within their technical grasp. If this leads to the anticipated success, it is likely the product is not of innovation but of ordinary skill and common sense. Zallo provides evidence that it is old and well known for a blade holders/sheaths to be provided on a structure mounted underneath a cabinet structure to prevent children from obtaining sharp objects (Fig.1). Newman

provides evidence that it is old and well known for an apparatus, not necessarily known for being associated with scissor use but located in an area where scissors are used, to incorporate a scissors holder/sheath with (Fig. 7).

- Claims 3, 7, and 10-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the PRESTO CAN OPENER PLUS (previously cited and, hereafter, to be called Presto) in view of Newman (2,720,189). In regards to claims 3, 7, 10, and 12, Presto discloses an electric can opener having a housing (first page of the instructions in Presto under cabinet automatic can opener plus) and a jar opener mounted on the bottom wall of the housing (page 8 of the instructions under to open jars). However, Presto fails to disclose, a sheath on the back of the housing for holding scissors or a holder on the housing capable of releasably retaining a scissors on the housing. Newman teaches that it is old and well known to incorporate a sheath or a holder on the housing capable of releasably retaining a scissors on the housing (18, 49, 55). Newman also shows that it is old and well known to incorporate a scissors holder/sheath on the back of all types of structures (Figs. 1, 5, 7, and 9) including structures not known for association with a pair of scissors (Fig. 7). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Presto's kitchen appliance with a holder/sheath, as taught by Newman, to allow for the appliance to retain a pair of scissors or a similar structure and because all claimed elements were known in the prior art and one skilled in the

art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results.

- Claim 10 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the PRESTO CAN OPENER PLUS (previously cited and, hereafter, to be called Presto) in view of Zelson (6,253,662). Presto discloses an electric can opener having a housing (first page of the instructions in Presto under cabinet automatic can opener plus). However, Presto fails to disclose a holder on the housing capable of releasably retaining a scissors on the housing. Zelson teaches that it is old and well known in the art of small appliances to incorporate a drawer/holder on a housing capable of releasably retaining a scissors (40). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Presto's kitchen appliance with a storage drawer, as taught by Zelson, to allow for the can opener appliance to releasable retain articles for storage and because all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results.

(10) Response to Argument

The examiner would like to point out that appellant's arguments A. and B. are directly related and that the examiner will address argument B. before A.

Appellant's argument regarding the reasoning for the 35 U.S.C. 112, second paragraph rejection is not correct. The can opener of the instant application incorporates a sheath with a scissors holder within the sheath (as clearly disclosed in claims 3 and 7). Basically, the sheath and scissors holder form a single sheath assembly that together holds a single pair of scissors. Now analyzing claims 10 and 11/13, claim 10 discloses a can opener with a scissors holder capable of retaining a scissors. Claims 11/13 further disclose a sheath for a scissors. So the combination of claims 10 and 11/13 discloses an opener with a sheath for a scissors and a scissors holder for a scissors. The 35 U.S.C. 112, second paragraph rejection is made because as written claims 10 and 11/13 incorporates two separate retaining structures. As written, there is no linking statement connecting the holder and the sheath structures to prevent the interpretation of individual retaining structures. One skilled in the art could interpret that the can opener could have two sheaths or a sheath and a drawer. Also, in claims 11 and 13, the sheath is for "a" scissors which clearly does not reference the "a" scissors of claim 10. In light of both the holder and the sheath being for a different pair of scissors, it is clear that one of ordinary skill in the art would interpret claims 10 and 11/13 as a can opener having two separate retaining structures. Basically, claims 10 and 11/13 need a "linking" structure that ties the holder and sheath structures together as in claims 3 and 7. Once again, as written the can opener of the instant application incorporate two separate retaining structures and without a linking statement linking the two retaining structures together, one of ordinary skill in the art would take this to mean that the can opener has two separate structures that each retains a scissors. The

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examiner provided two examples that overcome this rejection at the end of the 35 U.S.C. 112, second paragraph rejection above. With regards to the drawing objection, the drawings show a scissors holder within a sheath together forming a linked retaining assembly but what the Figures do not show is two separate retaining structures that each holds a separate pair of scissors. In Des. 417,129 to Brady et al. (Figure 4 shown below), the holder is not shown and it would be speculation to assume the holder is inside of the sheath. Now, when one may ask "Where is the sheath for the scissors?" and receive the following answer, "Over there on the can opener housing". It is clear that one would point to the item labeled "Sheath". But when faced with the follow-up question "if that's the sheath, where is the scissors holder?" One skilled in the art would not realize the holder is within the sheath because there is no linking statement and, therefore, would not know where the scissors holder is.

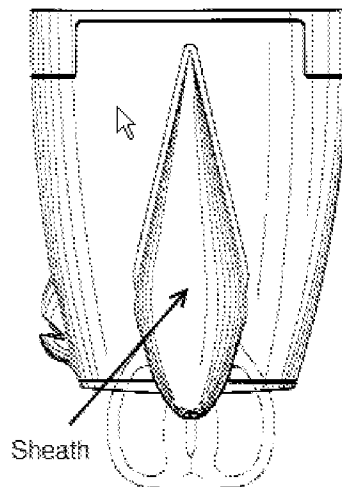


FIG. 4

With regards to the 35 U.S.C. 103(a) rejection over Presto (it is noted that a copy of the Presto reference has been attached to this examiner's answer) in view of Davies and Nielsen et al. with evidence patents Zallo and Newman, the examiner does have motivation to combine the references and, therefore, the examiner's position is correct. It is clear the Presto reference discloses all of the claimed electric can opener structure but fails to disclose a sheath or a scissors holder (hereafter called sheath holder assembly) on the housing. The Davies patent teaches a scissors sheath holder assembly that can be conveniently attached to another structure while the Nielsen et al. patent discloses numerous areas to which these sheath holder assemblies can be placed. In column 2 lines 10-35 Nielsen et al. disclose numerous different structures/appliances that it is old and well known to attach a tool holder. From the wide range of structures/appliances listed, one skilled in the art would realize that this tool holder could be attached to any type of structure/appliance and not to just the structures/appliances mentioned. In column 3 line 30-31 of Davies, it is stated that the holder can be positioned exactly where it is most convenient. The Newman patent provides additional evidence of numerous different types of block-type structures that can incorporate a scissors holder/sheath assembly and more importantly structures that are not necessarily associated with the use of the scissors can incorporate a scissors holder/sheath assembly (i.e. the thermometer of Fig.7). Next, it is clear that Presto is an under-cabinet can opener and Zallo provides evidence that it is old and well known for under-cabinet structures to be equipped with sheath holder assemblies capable of holding scissors. Zallo also provides evidence that it is old and well known to store

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cutlery in a safe area well out of reach of children. The claim would have been obvious because a person of ordinary skill has good reason to pursue the known options within their technical grasp. If this leads to the anticipated success, it is likely the product is not of innovation but of ordinary skill and common sense because of fact that it is old well known to attach tool holders to the most convenient spot, the list of structures/appliances to which a tool holder may be attached, the understanding that one skilled in the art would realize that tool holders could be attached to additional structures/appliances than the ones listed, that it is old and well known to have sheaths in an under-cabinet attached structure, and to store cutlery above where a child could reach, the Presto can opener is an appliance that one skilled in the art would recognize as a convenient under-cabinet structure that the tool holder may be attached to be out of the reach of children.

It is noted that during an interview, Mr. Dybvig pointed out a typo on page 20 lines 1 and 5-6 of argument paragraph 2. The first paragraph is a description of both claim 3 and 7, however lines 5-6 discloses "a sheath on the back of the housing" which is not disclosed in claim 3. It was determined that this typo was so minor and that it did not affect appellant's arguments nonetheless it was requested that this typo be pointed out.

With regards to the 35 U.S.C. 103(a) rejection over Presto (it is noted that a copy of the Presto reference has been attached to this examiner's answer) in view of Newman, the examiner does have motivation to combine the references and, therefore, the examiner's position is correct. It is clear the Presto reference discloses all of the

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claimed electric can opener structure but fails to disclose a sheath or a scissors holder (hereafter called sheath holder assembly) on the housing. Newman teaches it is old and well known for different types of substantially rectangular structures with different primary functions to incorporate a sheath holder assembly on their back and more importantly Newman teaches that structures not necessarily associated with being used with scissors are capable of incorporate scissors sheaths. Basically Newman teaches that scissors can be stored in all types of structure and more importantly teaches structures that incorporate substantially the same shape as the can opener of Presto having the sheath holder assembly. One skilled in the art would clearly recognize from the wide variety of structures shown incorporating scissors retainers that it would have been obvious to incorporate the opener of Presto with a means to store scissors. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Presto’s kitchen appliance with a holder/sheath, as taught by Newman, to allow for the appliance to retain a pair of scissors or a similar structure and because all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results.

With regards to the 35 U.S.C. 103(a) rejection over Presto (it is noted that a copy of the Presto reference has been attached to this examiner’s answer) in view of Zelson, the examiner does have motivation to combine the references and, therefore, the examiner’s position is correct. It is clear the Presto reference discloses all of the

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claimed electric can opener structure but fails to disclose a holder capable of releasably retaining a scissors on the housing. First, it is noted the term holder is extremely broad and that scissors are not positively claimed meaning if an item is capable of holding scissors it meets the limitation. It is also noted that scissors come in all sizes including a very small size. Zelson teaches it is old and well known in the art of appliances to incorporate storage drawers. The addition of storage or storage draws has been common practice in the art of manufacturing and design. A drawer can releasably retain scissors due to the drawer's ability to open and close. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Presto's kitchen appliance with a storage drawer, as taught by Zelson, to allow for the can opener appliance to releasably retain articles for storage and because all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results.

In conclusion, it has been determined that claim are obvious if a person of ordinary skill has good reason to pursue the known options within their technical grasp and further if this leads to the anticipated success, it is likely the product is not of innovation but of ordinary skill and common sense. In light of this determination, all individual combinations used in the rejections above feature known options within a person of ordinary skill's technical grasp. Also, appellant is arguing that there is no motivation to combine the references and does not argue that all of the claimed elements were known in the prior art because all of the combination of references

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feature all of the structure claimed and, therefore, one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results. It is noted that hindsight reasoning was not the reason for each combination rather the fact that it's well within the technical grasp of a person of ordinary skill to combine known structures.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Jason Daniel Prone/

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